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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,594	10/22/2003	Shigeru Nakamoto	500.41300CX1	6107

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ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-3873

EXAMINER

GANDHI, JAYPRAKASH N

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/689,594	Applicant(s) NAKAMOTO ET AL.	
	Examiner Jayprakash N Gandhi	Art Unit 2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 5 and 9 rejected under 35 U.S.C. 102(e) as being anticipated by Hirabayashi et al. (U. S. Patent 6,673,547).

Regarding claims 5 and 9, Hirabayashi discloses all the claimed limitations of a sample processing apparatus (figure 1), including a main unit 11, a recording device 34, and a display means 41, for simultaneously both information and abnormality.

APPARATUS CLAIMS MUST BE STRUCTU-RALLY DISTINGUISHABLE FROM THE PRIOR ART

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

FIG. 1 is a schematic diagram that illustrates a genome DNA analysis system as one of preferred embodiments of the present invention. The genome DNA analysis system mainly includes three structural assemblies: a sample-preparation system, a measurement system, and a control system. The sample preparation system includes a sample treatment part 11 for preparing a

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sample, a container 12 in which a cleaning fluid is filled, a pump 14, and a sampling part 15. A sample prepared by the sample preparation system is transferred to the measurement system through the sampling part 15. The measurement system includes an ionization part 21 having a gas-supply part 22, and a mass spectrometric part 24 that carries out an analysis of multiply-charged ions 23 generated from the ionization part 21. Furthermore, the control system includes: an output prediction part 32 that predicts the results to be obtained from the analysis based on the sample information transmitted from the sample treatment part 11; an output analysis part 35 that analyzes an output from the mass spectrometric part 24 of the measurement system; a data analysis part 33 that generates the results of the sample analysis by performing a comparison between a predicted output from the output prediction part 32 and an actual output from the output analysis part 35; a recording part 34 that makes a record of the analyzing results from the data analysis part 33; and a control part 31 that controls the sampling part 15 of the sample preparation system and the output analysis part 35. Furthermore, as shown in FIG. 1, a display part 41 may be provided on the genome DNA analysis system. The display part 41 displays any information on its screen. The information includes the current analyzing status of the system (i.e., the information for defining whether the system functions normally or abnormally) and the latest analyzing results that include a mass spectrum.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 6-7 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirabayashi et al.

The presence of other claimed limitations for the information are old and well known and would have been obvious to modify the information of Hirabayashi if desire to promote desired results.

The diagram illustrates a gas analysis system, divided into a control system (top) and a measurement system (bottom).

Control System (Top):

- Sample Treatment Part (11):** Receives sample gas from the measurement system and sends it to the sampling part (15).
- Control Part (31):** Manages the system, sending signals to the output prediction part (32), recording part (34), and the pump (14).
- Output Prediction Part (32):** Provides data to the data analysis part (33).
- Data Analysis Part (33):** Processes data and sends it to the output analysis part (35).
- Recording Part (34):** Records data from the control part (31) and the output analysis part (35).
- Output Analysis Part (35):** Analyzes output data and sends it to the display part (41).
- Display Part (41):** Shows the results of the analysis.

Measurement System (Bottom):

- Gas Supply Part (22):** Provides gas to the ionization part (23).
- Ionization Part (23):** Ionizes the gas sample.
- Pumps:** Two pumps are used to move gas through the system. One pump is located between the ionization part (23) and the measurement cell (24), and the other is located between the measurement cell (24) and the output analysis part (35).
- Measurement Cell (24):** Contains a sensor (25) and a filter (26) to measure the gas sample.
- Output Analysis Part (35):** Receives data from the measurement cell (24) and sends it to the display part (41).

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tanaka et al. discloses related art.
4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jayprakash N Gandhi whose telephone number is 571-272-3740. The examiner can normally be reached on 6:30-5:00 (Mon. - Thu.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P Picard can be reached on 571-272-3749. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jayprakash N Gandhi
Primary Examiner
Art Unit 2125

jng